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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,500	02/05/2001	Nicholas William Sincaglia	21685-06151	8385
758	7590	01/13/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				EHICHOYA, FRED I
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/777,500	SINCAGLIA ET AL.0
	Examiner	Art Unit
	Fred I. Ehichioya	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 22 November 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1, 2, 5, 9 - 15, 18, 20, 21, 23 - 57 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 9 - 15, 18, 20, 21, 23, 33 - 38, and 45 - 50 is/are rejected.  
 7) Claim(s) 9, 33, 45 and 57, is/are objected to.  
 8) Claim(s) 1, 2, 5, 9 - 15, 18, 20, 21, 23 - 57 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: RCE and Preliminary amendments, both filed November 22, 2004 to the original application filed 02/05/01.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/2004 has been entered.

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1, 24, 25, 28 – 32, 57 and 39 - 44 drawn to database or file accessing classified in class 707, subclass 1.

Group II. Claims 2, 5, 26, 27, and 51 - 56 drawn to distributed data processing classified in class 702, subclass 201.

Group III. Claims 9 – 15, 18, 20, 21, 23, 33 – 38, and 45 - 50 drawn to file or database maintenance classified in class 707, subclass 200.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions listed as Group I, Group II, and Group III are related as

subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention has separate utility as follows:

Group I has separate utility such as a method for obtaining media data in client device that includes requesting media data from a meta data server.

Group II has separate utility such as a distributed media system that includes a media service system managed by a media service provider.

Group III has separate utility such as a method for servicing media data request in a meta data server. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, search required for Group II is not required for Group I and Group III and search required for Group III is not required for Group I and Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During telephone conversation with Aloysius Au Yeung, Attorney for the Applicant, Registration Number 35,432 on December 7, 2004 a provisional election was

made without traverse to prosecute the invention of Group III, claims 9 – 15, 18, 20, 21, 23, 33 – 38, and 45 - 50. Applicant in reply to this Office action must make affirmation of this election. Claims 1, 2, 5, 24 – 32, 39 – 44, and 51 - 57 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

5. The numbering of claim 57 is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claims 9, 33 and 45 are objected to for failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification or in the claims in such a way as to reasonably convey to one skilled in the relevant art at the time the application was filed. "Separate and independently operated", "Substantive continuous

observation", "Substantive continuous observing" and "identification of an electronic device" were not described in the specification or claims in such clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. The dependent claims to the above independent claims also inherit these deficiencies and are therefore subject to this objection. Appropriate correction is required in the next Office Action.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9, 33 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,412,004 issued to Ling Tony Chen et al. (hereafter "Chen") in view of U.S. Patent 6,453,355 issued to Anne Jones et al (hereinafter "Jones").

Regarding claims 9, 33 and 45, Chen teaches a method for servicing media data requests in a meta data server, the method comprising:

receiving a media data request from a client, the request received by a meta data server (see column 11, lines 8 - 17),  
transmitting the meta data to the client for use by the client to locate the media data server to retrieve the media data(see column 4, lines 55 – 67).

Chen does not explicitly teach retrieving meta data associated with the media data request from a meta data database, the meta data identifying a media data server having the requested media data, the media data server being separate and independently operated from the meta data server, including without substantive continuous observation by, and communication with the meta data server.

Jones teaches retrieving meta data associated with the media data request from a meta data database, the meta data identifying a media data server having the requested media data, the media data server being separate and independently operated from the meta data server, including without substantive continuous observation by, and communication with the meta data server (see column 1, lines 64 – 67 and column 2, lines 1 – 6), an entity different from the media service provider (see column 5, lines 24 –29 and column 14, lines 1 – 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Jones with the teaching of Chen wherein meta-data is used to locate media data from the Internet. The term Internet refers to a network of networks. The motivation is that accessing the Internet facilitates the locating and transferring of this media data.

8. Claims 10, 11, 12, 13, 14, 15, 23, 35, 36, 37, 38, 47, 48, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jones and further in view of U.S. Patent 6,510,553 issued to Rajeeb Hazra (hereinafter "Hazra").

Regarding claim 10, Chen and Jones discloses the claimed subject matter as discussed in claim 9. However, Hazra teaches wherein the meta data contains an address of said media data servers, and the method further comprises (see column 6, lines 37 – 42):

designating said media data server a primary media data server, based upon at least criteria gathered from a communication network between the client and the media data servers (see column 5, lines 43 - 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Hazra with the teaching of Chen and Jones wherein meta-data is used to locate media data from the Internet. The motivation is that

the data are compressed and transmitted as audio stream. This makes the transmission much faster.

Regarding claim 11, Chen and Jones discloses the claimed subject matter as discussed in claim 10. However, Hazra teaches, wherein the media data server designated as a primary media data server is media data server having a lowest number of clients accessing media data among a community of media data servers having the media data (see column 5, lines 52 - 55).

Regarding claim 12, Chen and Jones discloses the claimed subject matter as discussed in claim 10. However, Hazra teaches wherein the media data server designated as a primary media data server is media data server having a highest reliability rating, among a community of media data servers having the media data (see column 5, lines 52 - 54).

Regarding claim 13, Chen and Jones discloses the claimed subject matter as discussed in claim 10. However, Hazra teaches wherein the media data server designated as a primary media data server is media data server having a highest data throughput, among a community of media data servers having the media data (see column 2, lines 51 - 55).

Regarding claim 14, Chen and Jones discloses the claimed subject matter as discussed in claim 10. However, Hazra teaches the primary media data server is designated by the meta data server (see column 8, lines 26 - 31).

Regarding claim 15, Chen and Jones discloses the claimed subject matter as discussed in claim 10. However, Hazra teaches the primary media data server is designated by the client (see column 5, lines 52 - 62).

Regarding claims 23, 35 and 47, Chen and Jones discloses the claimed subject matter as discussed in claims 9, 33 and 45 respectively. However, Hazra teaches wherein the meta data transmitted to the client are for a portion of the requested media data that is unusable without an additional portion of the requested media data, and the method further comprises:

receiving request from the client for additional meta data for the additional portion of the requested media data (see column 4, lines 61 - 67); and  
transmitting the additional meta data to the client (see column 5, lines 58 - 59).

Regarding claims 36 and 48, Hazra teaches the electronic device is a computer system (see column 5, lines 15 – 18).

Regarding claims 37 ands 49, Hazra teaches the requested media content is accessible from the electronic device over the Internet (see column 5, lines 15 – 21).

Regarding claims 38 and 50, Hazra teaches the requested media content is an audio file (see column 5, lines 55 – 59).

9. Claims 18, 21, 34 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jones and further in view U.S. Patent 6,385,596 issued to Philip R. Wiser et al (hereinafter “Wiser”).

Regarding claims 18, 34 and 46, Chen and Jones discloses the claimed subject matter as discussed in claims 9, 33 and 45 respectively. However, Wiser teaches wherein the requested media data are encrypted, and the method further comprises (see column 3, lines 51 – 63):

requesting decryption key for the requested media data from a meta data database, in response to another request from the client, subsequent to providing of the meta data, and retrieving of the media data by the client (see column 4, lines 33 – 36); and transmitting the decryption key to the client (see column 4, lines 36 – 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Wiser with the teaching of Chen and Jones wherein the additional media data is known only to the purchaser of these media data. The motivation is that these portion of the media data provide additional security measures in combination with the encryption mechanisms.

Regarding claim 21, Wiser teaches receiving a log-in request from said client over the communication network (see column 20, lines 19 – 43); and performing a client access permission verification (see column 20, lines 57 – 64 and column 22, lines 20 – 24).

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jones and further in view of U.S. Patent 6,209,787 issued to Takahito Iida (hereinafter “Iida”).

Regarding claim 20, Chen and Jones disclose the claimed subject matter as discussed in claim 9. Chen teaches wherein said meta data comprises at least one data item, said at least one data item selected from the list of:

    a network address of a primary media data server that has access to the media data (see column 7, lines 19 – 31);  
    a directory structure of the primary media data server (see column 9, lines 29 – 38);  
    a name of a file having the media data (see column 9, lines 39 – 45);  
    a network address of an alternate media data server that has access to the media data (see column 7, lines 19 – 31);  
    a directory structure of the alternate media data server (see column 9, lines 19 – 38);

a network address of a graphic image server that has access to a graphical image associated with the media data (see column 4, lines 21 – 23 and column 7, lines 19 – 31);

a directory structure of the graphical image server (see column 4, lines 21 – 23 and column 9, lines 29 - 31);

a network address of an information server that has access to additional information about artistic work contained in the media data (See column 7, lines 19 – 31; lida teaches “artistic work” in column 11, lines 26 – 36);

a directory structure of the information server (see column 9, lines 29 – 38; lida teaches “artistic work” in column 11, lines 26 – 36);

a network address of a sales server which offers a sale of the media data file (see column 7, lines 19 – 35);

a directory structure of the sales server (see column9, lines 29 – 38);

Chen or Jones does not explicitly teach a name of and owner of the media data; a name of a composer of the media data; a name of a copyright holder of the media data; a name of a graphical image file associated with the media data file; a title of an artistic work contained in the media data; a title of a body of work in which the media data is associated; a name of at least one performer of the media data; a name of at least one composer of artistic work contained on the media data; a name of at least one creators of the media data; a name of a file that contains additional information about artistic work contained in the media data; a name of a file that contains information on a sale of the media data; a network address of an associated

sales server which offers a sale of associated products of the media data; a directory structure of a storage device that contains sales information for the associated products of the media data file; and a name of a file that contains information on sales of associated products of the media data file.

lida teaches a name of an owner of the media data (see column 49, lines 20 – 67);

a name of a composer of the media data (see column 49, lines 20 – 67);

a name of a copyright holder of the media data (see column 40, lines 49 – 59);

a name of a graphical image file associated with the media data (see column 37, lines 58 – 67 and column 38, lines 1 – 2);

a title of an artistic work contained in the media data (see column 12, lines 17 – 25);

a title of a body of work in which the media data is associated (see column 11, lines 33 – 36 and column 17, lines 12 – 53);

a name of at least one performer of the media data(see column 12, lines 17 – 25 and column 17, lines 12 – 53);

a name of at least one composer of artistic work contained in the media data (see column 12, lines 17 – 25 and column 17, lines 12 – 53);

a name of at least one creators of the media data (see column 17, lines 12 – 53);

a name of a file that contains additional information about artistic work contained in the media data (see column 11, lines 26 – 36);

a name of a file that contains information on a sale of the media data (see column 77, lines 29 – 43);

a network address of an associated sales server which offers a sale of associated products of the media data (see column 75, line 23 and column 77, lines 29 – 45);

a directory structure of the associated sales server(see Chen: column 9, lines 29 – 38, column 79, lines 64 – 67 and column 80, lines 1 – 3); and

a name of a file that contains information on sales of associated products of the media data (see column 77, lines 29 – 43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Iida with the teaching of Chen and Wiser wherein videos, CDs, musical selections or any other multimedia data are selected and purchased over the network. The motivation is that this purchases are safe and secure due to encryption mechanism.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya  
Patent Examiner  
Art Unit 2162

January 8, 2005

Mohammed Ali  
Primary Examiner  
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